

40 years
1968-2008



Docket No.: 336549US



COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

RECEIVED

FEB 13 2009

OFFICE OF PETITIONS

RE: Application Serial No.: 09/139,307
Applicants: SHIRAKAWA, Takahashi
Filing Date: August 24, 1998
For: THERMAL HEAD
Group Art Unit: 2861
Examiner: Tran

SIR:

Attached hereto for filing are the following papers:

- Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b)
- Remarks and Evidence Supporting Petition for Revival Under 37 C.F.R. § 1.137(b)
- Declaration of Takao Fukasu in Support of the Petition for Revival Under 37 C.F.R. § 1.137(b)
- Copy of Date-Stamped Filing Receipt Evidencing Payment of Issue Fee and Submission of Replacement Drawing Sheets on February 10, 2009

Credit card payment is attached hereto in the amount of 1,620.00, to cover any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time.

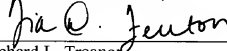
Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)
(OSMMN 10/08)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Richard L. Treanor
Registration No. 36,379

Tia D. Fenton
Registration No. 55,170

40 years
1968-2008



Docket No.: 336549US



ATTORNEYS AT LAW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RECEIVED

FEB 13 2009

OFFICE OF PETITIONS

RE: Application Serial No.: 09/139,307
Applicants: SHIRAKAWA, Takahashi
Filing Date: August 24, 1998
For: THERMAL HEAD
Group Art Unit: 2861
Examiner: Tran

SIR:

Attached hereto for filing are the following papers:

- Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b)
- Remarks and Evidence Supporting Petition for Revival Under 37 C.F.R. § 1.137(b)
- Declaration of Takao Fukasu in Support of the Petition for Revival Under 37 C.F.R. § 1.137(b)
- Copy of Date-Stamped Filing Receipt Evidencing Payment of Issue Fee and Submission of Replacement Drawing Sheets on February 10, 2009

Credit card payment is attached hereto in the amount of **1,620.00** to cover any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. **15-0030**. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time.

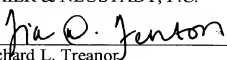
Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)
(OSMMN 10/08)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Richard L. Treanor
Registration No. 36,379

Tia D. Fenton
Registration No. 55,170

9

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Petitioner(s): Alps Electric Co., Ltd.

Serial No.: 09/139,307

For: Thermal Head

Filed: August 24, 1998

Examiner: Tran

Art Unit: 2861

Confirmation No.:

Customer No.:

RECEIVED

FEB 13 2009

OFFICE OF PETITIONS

Attorney Docket No. 9860-336549US

**Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

**REMARKS AND EVIDENCE SUPPORTING
PETITION FOR REVIVAL UNDER 37 C.F.R. § 1.137(b)**

Dear Sir:

In support of the attached Petition requesting revival of the present application under 37 C.F.R. § 1.137(b), Petitioner hereby submits the following remarks and evidence.

The Manual of Patent Examining Procedure ("MPEP") states that "[t]he Office does not generally question whether there has been an intentional ... delay" if the petition is filed "within 3 months of the date the applicant is first notified" of abandonment and "within one year of the date of abandonment of the application." If these criteria are not met, the Office may require further information on how such a delay was unintentional. See, MPEP § 711.03(c)(II)(D). Because the present Petition is being filed within 5 months of Petitioner learning of the

abandonment of the application and more than 1 year after abandonment of the application, and in order to evidence compliance with 37 C.F.R. § 11.18(b), Petitioner hereby provides a summary of facts and circumstances supporting a finding of unintentional delay in filing the required reply and grantable petition.

For the reasons set forth herein below, Petitioner submits that the entire delay in paying the issue fee and submitting corrected drawings until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional. Included with this Petition are (1) evidence that the issue fee and corrected formal drawings were filed today; (2) the fee for delayed payment as set forth in 37 C.F.R. § 1.17(m); and (3) the Declaration of Takao Fukasu ("Fukasu Dec.").

SUMMARY

At issue is the revival of U.S. Patent Application No. 09/139,307 ("the '307 Application") to inventors Takashi Shirakawa and Masakazu Kato, which went abandoned on November 9, 1999 for failure to pay the issue fee and submit corrected drawings required by the Notice of Allowance and Issue Fee Due mailed June 3, 1999. Alps Electric Co., Ltd. ("Petitioner") brings this Petition for Revival of the '307 Application under 37 C.F.R. § 1.137(b) for unintentional delay in paying the issue fee and submitting corrected drawings.

Petitioner never intended to delay paying the issue fee and submitting corrected drawings. In fact, until quite recently, Petitioner was unaware of the abandoned status of the '307 Application. Petitioner believed its attorney, William F. Prendergast ("Mr. Prendergast"), formerly of Brinks, Hofer, Gilson & Lione ("Brinks Hofer"), paid the issue fee and submitted corrected drawings to the United States Patent and Trademark Office ("the PTO"). But Mr. Prendergast never paid the issue fee or submitted corrected drawings and allowed the '307 Application to go abandoned. As discussed in detail below, Petitioner was deceived into

believing that the drawings had been filed and issue fee paid and that the '307 Application was still pending.

Petitioner submits that there can be no intent by Petitioner to delay in prosecuting the '307 Application when Petitioner believed corrected formal drawings were timely filed and the issue fee had been paid. Additionally, Petitioner demonstrated its intent to fully prosecute the '307 Application through its diligent prosecution of the Application, repeated inquiries about the status of the Application, and prompt action after learning of its abandonment. Mr. Prendergast's inaction and deceit, as well as Petitioner's intent to file the corrected drawings and issue fee, are detailed below and in the attached Declaration of Takao Fukasu. The chronology of events shows that the delay in submitting corrected drawings and paying the issue fee was unintentional from the due date for the reply to the present date.

LEGAL STANDARD

An application that has become abandoned for failure to prosecute may be revived if the delay in responding was unintentional. See, 37 C.F.R. § 1.137(b). The MPEP states that "[t]he Office does not generally question whether there has been an intentional ... delay" if the petition is filed "within 3 months of the date the applicant is first notified" of abandonment and "within 1 year of the date of abandonment of the application." If these criteria are not met, the Office may require further information on how such a delay was unintentional. See, MPEP § 711.03(c)(II)(D).

In determining whether a delay was unintentional, "[t]he inquiry is directed only to whether the course of action resulting in the delay was unintentional." Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159, *20-21 (D. Minn. Jan. 27, 2005). Abandonment is not unintentional "when an applicant reviewing the same facts changes his mind

as to the appropriate course of action to pursue. An application abandoned as a result of a deliberative, intentional course of action ... does not amount to an unintentional abandonment within the meaning of 37 C.F.R. 1.137(b).” In re Maldague, 10 U.S.P.Q.2d 1477 (Comm’r Pat. & T.M. 1988). On the other hand, an application abandoned based on a deliberate decision, but made on mistaken information, is properly revived as unintentionally abandoned. See, Goss Int’l Americas, Inc. v. MAN Roland, Inc., 2006 U.S. Dist. LEXIS 53245, *13-16 (D. N.H. Jul. 31, 2006). Thus, it is appropriate to find unintentional delay in circumstances in which the applicant was acting on incomplete or mistaken information, with respect to the abandoned patent application.

Relevantly, one Court stated that “[p]laintiff never intended to abandon his application,” based on the fact that “on numerous occasions, plaintiff, or its representatives, inquired of [the party responsible for prosecution] as to the status of the application. However, due to circumstances surrounding the relationship between plaintiff and [the party responsible for prosecution], plaintiff was unable to timely prosecute the application.” Futures Tech., Ltd. v. Donald J. Quigg, Comm’r Pat. & T.M., 684 F.Supp. 430, 431 (E.D. Va. 1988). While Futures Tech. was decided under the more stringent unavoidable delay standard,¹ the Court’s comments regarding the plaintiff’s intentions are instructive in determining unintentional delay. For instance, an applicant’s repeated status inquires with respect to the relevant patent application weigh in favor of a finding of unintentional delay.

It is worth noting that, in general, a party is bound by the acts of its lawyer. See, e.g., Link v. Wabash R.R., 370 U.S. 626, 633-34 (1962). The Courts and PTO, however, have recognized exceptions to this rule. One exception is when the very attorney the client relies upon

¹ See, MPEP § 711.03(c), which notes that petitions to revive for unintentional delay are “less burdensome” than petitions to revive for unavoidable delay.

for expertise and wise counsel instead deceives the client. See, e.g., L.P. Steuart, Inc. v. Matthews, 329 F.2d 234, 235 (D.C. Cir. 1964), cert. denied, 379 U.S. 824 (1964); Jackson v. Washington Monthly Co., 569 F.2d 119, 122-23 (D.C. Cir. 1977); General Motors Corp. v. Cadillac Club Fashions Inc., 22 U.S.P.Q.2d 1933 (Trademark Trial & App. Bd. 1992); In re Lonardo, 17 U.S.P.Q.2d 1455 (Comm'r Pat. & T.M. 1990).

In re Lonardo² is an example of the Commissioner applying above-noted the exception in a case in which a patent attorney concealed the abandonment of a patent application and deceived the applicant into believing that the application was still pending at the PTO. Although Lonardo was decided under the stricter unavoidable delay standard, it is noteworthy that the Commissioner revived a patent application after fourteen years of abandonment, on the basis that the applicant had been intentionally deceived by his attorney. See, In re Lonardo, 17 U.S.P.Q.2d at 1455-58. The attorney in Lonardo, unbeknownst to the applicant, allowed the patent application to go abandoned. When Lonardo inquired about the status of the application, the attorney concealed the abandonment and misled Lonardo into believing that the application was still pending at the PTO. In that case, the Commissioner found that the attorney's lack of diligence was not chargeable to the petitioner because of the "attorney's intentional deception of his client." Id. at 1458 (emphasis added). Thus, an attorney's lack of diligence or delay should not be charged to the petitioner if the attorney intentionally deceived his/her client with respect to the prosecution of the patent application.

Overall, in light of the relevant case law, in determining unintentional delay it is appropriate to consider the actions of the petitioner, including petitioner's inquiries with regard

² The Federal Circuit has addressed the Lonardo decision, stating that it is not bound by the decision. Huston v. Ladner, 973 F.3d 1564, 1567 (Fed. Cir. 1992). Importantly, though, the Federal Circuit did not reject or even criticize the Lonardo decision. Rather, it simply did not apply Lonardo because the case before it was factually distinguishable. Id. Huston dealt with a situation in which the attorney did not understand the substantive law. Huston did not address a situation in which an attorney intentionally deceived the applicant.

to the status of the application, without charging the actions of the deceitful attorney to the petitioner. As will be shown for the '307 Application, the entire delay in filing the corrected drawings and paying the issue fee, from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional on the part of the Petitioner.

RELEVANT FACTS AND ARGUMENT

Petitioner did not intend to delay paying the issue fee and submitting corrected drawings. Fukasu Dec. ¶¶ 6, 10. Based on Mr. Prendergast's representations, Petitioner believed Mr. Prendergast timely paid the issue fee and submitted corrected drawings, and that a patent would be issued. Fukasu Dec. ¶ 7. Unbeknownst to Petitioner, however, Mr. Prendergast failed to pay the issue fee and submit corrected drawings, and allowed the '307 Application to go abandoned. Fukasu Dec. ¶¶ 6-7, 9. Petitioner intended to, and did, fully prosecute the '307 Application. Fukasu Dec. ¶¶ 6, 9. This is shown, in part, by Petitioner's provision of comments and materials to Mr. Prendergast enabling the successful prosecution of the '307 Application. Fukasu Dec. ¶ 5. Petitioner's lack of intent to delay paying the issue fee is also demonstrated by its timely prosecution of the '307 Application up until the Notice of Allowance, repeated inquiries with respect to the status of the '307 Application, and prompt action after learning of the abandonment of the '307 Application, all of which is detailed below and in the Declaration of Takao Fukasu. See, Fukasu Dec. ¶ 5.

Although there is limited case law regarding revival for unintentional delay, the cases discussed in the legal section above set forth a framework for determining what is and what is not unintentional delay. It is not unintentional delay when a party pursues a deliberate, intentional course of action only to change its mind upon further review. See, In re Maldague, 10 U.S.P.Q.2d at 1478. On the other hand, revival is appropriate for unintentional delay where a

deliberate decision to abandon the application was made based on mistaken information, see, Goss Int'l Americas, Inc., 2006 U.S. Dist. LEXIS 53245 at *13; revival is also appropriate where an attorney intentionally deceived his/her client. See, In re Lonardo, 17 U.S.P.Q.2d at 1458. This is not a case in which Petitioner pursued a deliberate, intentional course of action only to change its mind after further review of the facts and circumstances. Rather, this is a case in which Petitioner intended to pursue the '307 Application, only to be deceived by its attorney, Mr. Prendergast, who allowed the Application to go abandoned. Petitioner's repeated status inquires with respect to the relevant patent Application weigh in favor of a finding of unintentional delay. See, Futures Tech., 684 F.Supp. at 431.

The '307 application was filed on August 24, 1998 as a continuation-in-part of application 08/697,153 ("the '153 Application"). Though the '153 Application is not at issue in this petition, the prosecution history of that Application is instructive. As with the '307 Application prosecution discussed in detail below, Petitioner diligently prosecuted the '153 Application. In particular, on at least three occasions Petitioner contacted a prosecuting attorney at Brinks Hofer to inquire about the status of the '153 Application. Petitioner submits that its actions in the parent case further indicate Petitioner's desire not to delay in responding to communications from the PTO in the prosecution of the '307 Application.

During prosecution of the '307 Application, the Examiner issued a Notice to File Missing Parts of Application on September 9, 1998. Responding on November 2, 1998, the requested Declaration and Power of Attorney with the appropriate fee was filed. The next communication from the PTO was the Notice of Allowance, issued on June 3, 1999. Mr. Prendergast forwarded the Notice of Allowance to Petitioner on June 14, 1999, and instructed Petitioner that he would pay the issue fee and file the formal drawings, unless Petitioner instructed otherwise. Fukasu

Dec. ¶ 5. Petitioner did not instruct Mr. Prendergast not to pay the fee or submit the drawings and fully expected Mr. Prendergast to pay the issue fee and submit the drawings, as his June 14, 1999 letter indicated he would. Fukasu Dec. ¶¶ 5-6, 10.

Having not received the patent, on December 28, 2006, Petitioners inquired about the status of a number of applications, including the '307 Application. Fukasu Dec. ¶ 5. Mr. Prendergast responded on January 11, 2007, informing Petitioners that the files, including the '307 Application file, had been lost by the PTO but that Petitioners could expect to receive some action from the PTO in two to three months. Fukasu Dec. ¶ 5. Petitioners again contacted Mr. Prendergast on July 11, 2007 regarding the status of the cases, including the '307 Application. Fukasu Dec. ¶ 5. Responding on July 14, 2007, Mr. Prendergast informed Petitioner that he had contacted the PTO to inquire about the status of the applications. Fukasu Dec. ¶ 5. Finally, on March 2, 2008 and June 19, 2008, Petitioner again contacted Mr. Prendergast with status inquiries on the applications, including the '307 Application. Fukasu Dec. ¶ 5.

Shortly thereafter, on September 10, 2008, Brinks Hofer informed Petitioner of the abandoned status of the '307 Application. Fukasu Dec. ¶ 9. Upon learning of the abandonment of the Application, Petitioner promptly launched an investigation of the matter and has been working to take corrective action since that time. Fukasu Dec. ¶ 11. Specifically, Petitioner reviewed the '307 Application file, and several other similarly situated unintentionally abandoned applications, internally and addressed the matter extensively with Brinks Hofer. Fukasu Dec. ¶ 11. Subsequently, Petitioner began the process of retaining new patent counsel, including identifying potential law firms with substantial experience and native Japanese speaking attorney(s), interviewing counsel, and ultimately retaining a new law firm. Fukasu Dec. ¶ 11. Since that time, Petitioner has been working with new patent counsel to provide it

with the information necessary to fully investigate and file the present Petition to Revoke.

Fukasu Dec. ¶ 11.

Petitioner never intended to delay in paying the issue fee and submitting corrected drawings. Fukasu Dec. ¶¶ 6, 10. Throughout the entire relevant time period, from the due date for the reply to the present, Petitioner did not intend to delay in paying the issue fee and submitting corrected drawings. Fukasu Dec. ¶¶ 6, 10. Petitioner relied on Mr. Prendergast as worthy and reliable counsel, and assumed, based on Mr. Prendergast's repeated representations, that the '307 Application was pending at the PTO for the past several years, awaiting action by the PTO. Despite continued communications and status inquiries over the past several years, Mr. Prendergast never informed Petitioner that the issue fee was not paid, that the corrected drawings were not submitted, or that the '307 Application went abandoned. To the contrary, Mr. Prendergast went to great lengths to deceive Petitioner into believing that the prosecution of the '307 Application was ongoing, but delayed due to circumstances within the PTO. Fukasu Dec. ¶ 8.

There can be no intent by Petitioner to delay in paying the issue fee and submitting drawings when Petitioner believed the issue fee had been paid and the drawings had been submitted. Petitioner made repeated status inquiries with respect to the '307 Application. Moreover, as soon as Petitioner learned of the abandonment of the '307 Application, it took action to investigate the matter and hire new patent counsel to file the present Petition to Revoke.

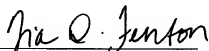
Clearly, this is not a situation in which Petitioner made a deliberate decision to delay filing a reply. Quite the opposite, Petitioner's actions evince a definite intent not to delay, but to pursue the '307 Application. In this instance, the delay in paying the issue fee and filing the corrected drawings comes, not from any planned course of action by the Petitioner, but from the

deliberate actions and inactions of its attorney, Mr. Prendergast. And as set forth in the legal section above, Mr. Prendergast's intentionally deceptive actions with respect to the '307 Application should not be charged to Petitioner. In Lonardo, although decided under the higher unavoidable delay standard, the Commissioner held that an attorney's lack of diligence will not be charged to the client when the attorney intentionally deceived the client. See, In re Lonardo, 17 U.S.P.Q.2d at 1458. Thus, based on the relevant case law, Petitioner should not be charged with Mr. Prendergast's intentionally deceptive actions.

Petitioner submits that, under the legal and factual circumstances set forth above and in the Declaration of Takao Fukasu, a finding that the entire delay in submitting the issue fee and corrected drawings was unintentional is appropriate. For the reasons set forth herein, Petitioner respectfully requests that the Commissioner grant this Petition to Revive the '307 Application under 37 C.F.R. § 1.137(b) as being unintentionally delayed.

Date: February 10, 2009

Respectfully submitted,


Richard L. Treanor
Reg. No. 36,379
Tia D. Fenton
Reg. No. 55,170
Attorneys for Petitioner
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke St.
Alexandria, VA 22314
Tel: (703) 413-3000
Fax: (703) 413-2220



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Petitioner(s): Alps Electric Co., Ltd.

RECEIVED

Serial No.: 09/139,307

FEB 13 2009

For: Thermal Head

OFFICE OF PETITIONS

Filed: August 24, 1998

Examiner: Tran

Art Unit: 2861

Confirmation No.:

Customer No.:

Attorney Docket No. 9860-336549US

**Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

**DECLARATION OF TAKAO FUKASU IN SUPPORT OF THE
PETITION FOR REVIVAL UNDER 37 C.F.R. § 1.137(b)**

1. I am Senior Manager in the Intellectual Property Department at Alps Electric Co., Ltd. ("Petitioner"). In this capacity, I am familiar with the prosecution of Petitioner's U.S. patent applications, Petitioner's IP business practices, Petitioner's docketing procedures, how Petitioner interacts with and directs outside counsel in the United States, and, based on my personal knowledge, experience and position at Alps Electric Co., Ltd., can speak on behalf of Petitioner in this matter.
2. The focus of this Declaration is on the prosecution of U.S. Patent Application No. 09/139,307 ("the '307 Application"). Petitioner was the only entity communicating with U.S. counsel regarding the prosecution of the '307 Application.

3. The facts set forth in this Declaration are those that I believe to be relevant to the United States Patent and Trademark Office ("the PTO") in deciding whether to grant the Petition to Revive the '307 Application under 37 C.F.R. § 1.137(b) (unintentional abandonment).
4. As assignee of 100% interest in the '307 Application, Petitioner has the authority under 37 C.F.R. § 3.73 to petition to revive the '307 Application.
5. On December 24, 2008, Petitioner sent a copy of five file histories of five unintentionally abandoned U.S. patent applications, including its file history relating to the prosecution of the '307 Application, to Oblon, Spivak, McClelland, Maier & Neustadt ("Oblon Spivak"). Oblon Spivak confirmed receipt on December 30, 2008. This '307 file history included copies of all of the correspondence with U.S. counsel in Petitioner's possession relating to the '307 Application. Below is a list of the correspondence Petitioner provided to Oblon Spivak:

Date	Description of Document
7/9/1998	Facsimile from William Prendergast of Brinks Hofer Gibson & Lione ("Brinks Hofer") to T. Fukasu of Alps Electric Co., Ltd. ("Alps") regarding filing of continuation application.
8/6/1998	Facsimile from T. Fukasu of Alps to Allan Sternstein of Brinks Hofer enclosing instructions on filing continuing application with attached Preliminary Amendment.
8/28/1998	Letter from William Prendergast of Brinks Hofer to T. Fukasu of Alps enclosing materials filed with PTO in connection with the continuation-in-part Application No. 09/139,307.
10/2/1998	Letter from William Prendergast of Brinks Hofer to Yukimitu Manabe of Alps enclosing Notice to File Missing Parts and discussing requirements for Declaration and Assignment.
10/21/1998	Letter from Y. Manabe of Alps to Allan Sternstein enclosing executed Declaration and Power of Attorney.
10/28/1998	Letter from William Prendergast of Brinks Hofer to Y. Manabe of Alps enclosing copies of documents filed with PTO and transmittal documents.
3/17/1999	Letter from William Prendergast of Brinks Hofer to Y. Manabe of Alps enclosing original Assignment and copy of assignment

	digest assigning invention to Alps.
3/29/1999	Facsimile from Y. Manabe of Alps to William Prendergast of Alps acknowledging receipt of original Assignment.
6/14/1999	Letter from William Prendergast of Brinks Hofer to Y. Manabe of Alps enclosing Notice of Allowance and instructions re payment of issue fee and filing of formal drawings.
12/28/2006	Letter from T. Fukasu of Alps to Gustavo Siller, Jr. of Brinks Hofer inquiring about the status of four Alps applications, including the '307 Application.
1/11/2007	Facsimile from William Prendergast of Brinks Hofer to T. Fukasu of Alps responding to December 28 inquiry.
7/14/2007	e-mail from William Prendergast of Brinks Hofer to A. Takeda of Alps re inquiry re status of Alps applications
3/2/2008	e-mail from A. Takeda of Alps to William Prendergast of Brinks Hofer inquiring about status of Alps applications.
3/3/2008	e-mail from William Prendergast of Brinks Hofer to A. Takeda of Alps re status of Alps applications.
6/19/2008	e-mail from A. Takeda of Alps to William Prendergast of Brinks Hofer inquiring about status of Alps applications.

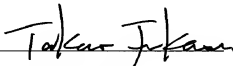
6. Petitioner at no time intended to delay paying the issue fee or filing corrected drawings in response to the June 3, 1999 Notice of Allowance and Issue Fee Due, during the entire period from the due date of the reply to the Notice of Allowance and Issue Fee Due to the present date.
7. Petitioner believed the issue fee was timely paid and the corrected drawings were timely filed with the PTO.
8. Petitioner believed that the prosecution of the '307 Application was delayed several years due to inaction by the PTO.
9. Until September 10, 2008, Petitioner was unaware of the abandoned status of the '307 Application and of the abandoned status of several other similarly situated applications.
10. Petitioner never requested Brinks, Hofer, Gilson & Lione ("Brinks Hofer") or Mr. Prendergast, or any other attorney or Patent Agent, to delay any filing necessary to

the prosecution and Issuance of the '307 Application, or to abandon the '307 Application.

11. Upon learning of the abandonment of the '307 Application, and the abandonment of several additional U.S. patent applications Petitioner then believed were pending, on September 10, 2008, Petitioner promptly investigated the matter internally and with Brinks Hofer attorneys, including reviewing the '307 Application file history and participating in discussions regarding the circumstances that led to the abandonment of the '307 Application and the several other applications. Thereafter, Petitioner chose to retain new patent counsel to take appropriate action to revive the abandoned applications, including identifying new law firms with experience in such matters and having native Japanese speaking attorney(s), interviewing potential new patent counsel, hiring new patent counsel, and working with new counsel to enable them to file petitions to revive the applications.

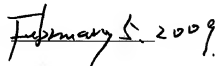
I declare under the penalty of perjury in the United States that the foregoing is true and correct, to the best of my knowledge.

Signature



Takao FUKASU
Senior Manager
Intellectual Property Department
ALPS ELECTRIC CO., LTD.

Date





Dept.: Chemical
By: RLT/TDF/dsb

RECEIVED

FEB 13 2009

OFFICE OF PETITIONS

OSMM&N File No. 336549US

Serial No. 09/139,307

In the matter of the Application of: Takahashi SHIRAKAWA

For: THERMAL HEAD

Due Date: n/a

The following has been received in the U.S. Patent Office on the date stamped hereon:

- PTO Cover Letter
- Issue Fee Transmittal
- Letter Submitting Replacement Drawing Sheets
- Notice of Allowability Dated June 3, 1999 (copy)
- PTO Form 948 Dated November 12, 1998 (copy)
- 6 Replacement Drawing Sheets
- Credit Card Payment in the amount of \$1,510.00
- Deposit Account Authorization



COPY

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**Docket Number (Optional)
336549US

First named inventor: Takashi SHIRAKAWA

Application No.: 09/139,307

Art Unit:

Filed: August 24, 1998

Examiner: Tran

Title: THERMAL HEAD



FEB 13 2009

OFFICE OF PETITIONS

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee
☐ Small entity-fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☒ Other than small entity - fee \$ 1,620.00 (37 CFR 1.17(m))
2. Reply and/or fee

- A. The reply and/or fee to the above-noted Office action in the form of Replacement Drawings (identify type of reply):

☒ has been filed previously on even date (February 10, 2009).
☐ is enclosed herewith.

- B. The issue fee and publication fee (if applicable) of \$ 1,510.00.

☒ has been paid previously on even date (February 10, 2009).
☐ is enclosed herewith.

(Page 1 of 2)

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

02/11/2009 AHONDAF1 00000138 09139307

01 FC:1453

1620.00 0P

3. Terminal disclaimer with disclaimer fee

☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Tia D. Fenton
Signature

2-10-09
Date

Tia D. Fenton
Typed or printed name

55,170
Registration Number, if applicable

Oblon Spivak
Address

703-413-3000
Telephone Number

1940 Duke Street, Alexandria, Virginia 22314
Address

Enclosures: ☒ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☒ Additional sheets containing statements establishing unintentional delay

☒ Other: Date-Stamped Filing Receipt evidencing Issue Fee/Drawings Submission

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

- ☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.
- ☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

Date

Signature

Typed or printed name of person signing certificate

40 years
1968-2008



Docket No.: 336549US



COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

RECEIVED

FEB 13 2009

OFFICE OF PETITIONS

RE: Application Serial No.: 09/139,307
Applicants: SHIRAKAWA, Takahashi
Filing Date: August 24, 1998
For: THERMAL HEAD
Group Art Unit: 2861
Examiner: Tran

SIR:

Attached hereto for filing are the following papers:

- Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b)
- Remarks and Evidence Supporting Petition for Revival Under 37 C.F.R. § 1.137(b)
- Declaration of Takao Fukasu in Support of the Petition for Revival Under 37 C.F.R. § 1.137(b)
- Copy of Date-Stamped Filing Receipt Evidencing Payment of Issue Fee and Submission of Replacement Drawing Sheets on February 10, 2009

Credit card payment is attached hereto in the amount of 1,620.00 to cover any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time.

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)
(OSMMN 11/05)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Richard L. Treanor
Registration No. 36,379

Tia D. Fenton
Registration No. 55,170

40 years
1968-2008



Docket No.: 336549US



COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

RE: Application Serial No.: 09/139,307
Applicants: SHIRAKAWA, Takahashi
Filing Date: August 24, 1998
For: THERMAL HEAD
Group Art Unit: 2861
Examiner: Tran

RECEIVED

FEB 13 2009

OFFICE OF PETITIONS

SIR:

Attached hereto for filing are the following papers:

- Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b)
- Remarks and Evidence Supporting Petition for Revival Under 37 C.F.R. § 1.137(b)
- Declaration of Takao Fukasu in Support of the Petition for Revival Under 37 C.F.R. § 1.137(b)
- Copy of Date-Stamped Filing Receipt Evidencing Payment of Issue Fee and Submission of Replacement Drawing Sheets on February 10, 2009

Credit card payment is attached hereto in the amount of 1,620.00, to cover any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time.

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)
(OSMMN 10/08)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Richard L. Treanor
Registration No. 36,379

Tia D. Fenton
Registration No. 55,170

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)
335549US

First named inventor: Takashi SHIRAKAWA

Application No.: 09/139,307

Art Unit:

Filed: August 24, 1998

Examiner: Tran

Title: THERMAL HEAD



FEB 13 2009

OFFICE OF PETITIONS

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity-fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☒ Other than small entity - fee \$ 1,620.00 (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in
the form of Replacement Drawings (identify type of reply):

- ☒ has been filed previously on even date (February 10, 2009).
☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ 1,510.00.

- ☒ has been paid previously on even date (February 10, 2009).
☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identify theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

2-10-09
Date

55.170

Registration Number, if applicable

703-413-3000
Telephone Number

Address

☐ Reply

☐ Terminal Disclaimer Form

☒ Additional sheets containing statements establishing unintentional delay

☒ Other: Date-Stamped Filing Receipt evidencing Issue Fee/Drawings Submission

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

Date _____

Signature _____

Typed or printed name of person signing certificate